

## II. REMARKS

1. Claims 1-3 remain in the application.
2. Claims 1-3 are patentable over the combination of Howard et al (US 6,222,531, "Howard") in view of Engler et al. (US 6,383,619, "Engler").
3. Applicant respectfully submits that Howard is not available as a reference.

As pointed out by the Examiner, as of November 29, 1999, subject matter that was prior art under former 35 USC 103 via 35 USC 102(e) is now disqualified if that subject matter and the claimed invention were commonly owned, or subject to an obligation of assignment to the same person, at the time of the invention.

The present application was filed on 26 January 2001, and thus was filed after November 29, 1999.

The present application, Serial No. 09/770,430 and Howard, U.S. Patent No. 6,222,513 were, at the time the present invention was made, owned by Xerox Corporation.


The assignment of the present application, Serial No. 09/770,430, to Xerox Corporation, 800 Long Ridge Road, Stamford, CT, was recorded on 1/26/2001, on reel 011534, frame 0307. The assignment of US 6,222,513 to Xerox Corporation, 800 Long Ridge Road, Stamford, CT, was recorded on 3/10/1998, on reel 009060, frame 0494.

At least for these reasons, Applicant respectfully submits that the combination of Howard and Engler fails to render claim 1 and dependent claims 2 and 3 unpatentable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,

  
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8/24/04  
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#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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